Supreme Court, U.S.
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In The
Supreme Court of the United States

SLIP TRACK SYSTEMS, INC.,
Petitioner,

v.

METAL-LITE, INC.,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether it is ever appropriate when the meaning of a patent claim is clear on its face to use the patent file history to import an ambiguity into the claim that then must be resolved by importing an additional limitation from the file history.

2. Whether it is appropriate to apply of the doctrine of prosecution history disclaimer when the intrinsic record directly contradicts the allegedly disavowing statement and the record as a whole does not show a clear and unmistakable disavowal.

3. Whether the doctrine of prosecution history disclaimer, as conceptually distinct from prosecution history estoppel, should be limited to amendments or arguments made to overcome prior art.

LIST OF PARTIES TO THE PROCEEDING

The parties to this proceeding are set forth in the caption.

RULE 29.6 STATEMENT

There are no parent companies, subsidiaries, and affiliates of Petitioner Slip Track Systems, Inc. that have issued shares to the public.

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PETITION FOR WRIT OF CERTIORARI

Petitioner Slip Track Systems, Inc. hereby respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit ("Federal Circuit").

OPINION BELOW

The opinion of the Federal Circuit is reported at 113 Fed. Appx. 930 and reproduced in Petitioner's Appendix (hereinafter "App.") at App. A at 1. The order denying panel rehearing and denying rehearing *en banc* is reported at 2005 U.S. App. LEXIS 4046 (Fed. Cir., Feb. 2, 2005) and is reproduced in App. A at 64.

JURISDICTION

Judgment of the Federal Circuit was entered on December 1, 2004. (App. A at 1). The order denying panel rehearing and denying rehearing *en banc* issued on February 2, 2005. (App. A at 64). This Court has jurisdiction under 28 U.S.C. §1254(1).

STATUTORY PROVISIONS INVOLVED

Pertinent provisions of the Patent Code (35 U.S.C. §112) are set forth in App. A at 66.

STATEMENT OF THE CASE

This Petition is taken from a divided panel decision of the Federal Circuit affirming in part, vacating and remanding in part a district court judgment of infringement of United States Patent No. 5,127,760 (the "'760 patent").[1]

I. Statement of the Facts

A. The Invention of the '760 Patent

Slip Track is the owner of the '760 patent for a Vertically Slotted Header. The '760 patent is for a "slotted track" wall assembly used to alleviate stress on a wall's infrastructure caused by environmental forces, such as earthquakes. (App. B at 5). As described in the "Field of Invention," the '760 patent relates to a "building construction assembly and, more particularly, to a header for allowing horizontal, non-load bearing headers to vertically fluctuate in relationship to vertical non-load bearing wall studs to which the headers are attached. By allowing the header freedom of vertical movement, the walls that are fixed to the vertical studs are protected from cracking because the freedom of vertical movement of the header prevents translation of mechanical stresses to the walls caused by downward, environmental forces on the header." (App. B at 8).

A "header" is a horizontal frame member at the top of a wall. A "stud" is a vertical frame member. The header has flanges with vertical slots formed therein, and the stud has a hole formed proximal to its top end. The header is assembled astride the top end of the stud by an "attachment means" passing through the slot and the hole, such that the

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1 The Final Judgment and Permanent Injunction of the District Court for the Central District of California is set forth in App. A at 28. The '760 Patent is set forth in App. B at 5.

header is permitted a degree of vertical travel along the length of the slot relative to the stud.

B. Prosecution of the '760 Patent

The patent application that eventually issued as the '760 patent was filed on July 26, 1990. (App. B at 11; App. A at 213). The application as originally filed contained nine claims, including two independent claims.[2] Claim 1 recited:

> 1. A building construction assembly that includes a header and a stud wherein the header is capable of vertical movement relative to said stud comprising:
>
> a header having a web and flanges with said flanges connected to said web;
>
> at least one of said flanges having at least one vertical slot therein;
>
> a stud having a width less than the distance between said flanges of said header;
>
> said stud being aligned with said vertical slot; and
>
> an attachment means passing through said slot to unit [sic] said header to said stud whereby said slot permits said header to move vertically with respect to said stud while restricting horizontal movement of said header.

(App. B at 19; App. A at 220). Correspondingly, the written description sets forth two preferred methods for assembling the invention. In the first embodiment, the stud is inserted into the header, and then a hole is 'tapped' therein by a screw.

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[2] Beside original Claim 1, Claim 6 was an independent claim; however, Claim 6 is irrelevant to the issues being raised in this petition as it was a Jepson claim that was subsequently cancelled. (App. A at 213).

> The preferred method for assembling the invention involves placing end 40 of stud 12 between flanges 16 so that the end 40 abuts against the bottom 30 of the web 14 such that the header 10 and the stud 12 are perpendicular to each other and a vertical slot 24 is generally centered on side 52 of the stud 12. Appropriate attachment means, such as a self-tapping screw 20, is positioned in the slot 24 midway between the bottom 41 of the slot 24 and the top 42 of the slot 24. Once positioned, the self-tapping screw 20 is drilled into the stud 12.

(App. B at 16; App. A at 218). In the second embodiment, a pre-drilled hole is provided to align the stud and header:

> In another method of assembling the invention, holes 22 are pre-drilled in the stud 12. The stud 12 is then inserted between said flanges 16 so that the holes 22 in said stud are aligned with the slots 24. The attachment means 20 passes through the slot 24 and through the hole 22 in the stud 12.

(App. B at 17; App. A at 218). The basic difference between the first and second embodiments is that in the first embodiment the hole is tapped at the time of assembly, whereas in the second embodiment the hole is pre-drilled.

In the first Office Action, the United States Patent and Trademark Office ("PTO") rejected all nine claims under 35 U.S.C. §112 as being indefinite. (App. A at 204). Specifically, in his rejection of Claim 1, the PTO examiner questioned, "how is the stud aligned with the vertical slot...?"

In the Response to Examiner's Office Action (App. A. at 192), the applicant amended the claims and, in particular, amended Claim 1 to read as follows (with deletions in brackets and additions underlined):

> 1. A building construction assembly that includes a header and a stud wherein the header is capable of vertical movement relative to said [stud] assembly comprising:
>
> a header having a web and flanges with said flanges connected to said web;
>
> at least one of said flanges having at least one vertical slot therein;
>
> a stud having a width less than the distance between said flanges of said header and having a top end;
>
> said stud [being aligned with said vertical slot] having at least one hole formed therein proximal to said top end; [and] said top end fitting between said flanges perpendicular to said header positioned so that said hole is aligned with said vertical slot; and
>
> an attachment means passing through said slot to [unit] slideably unite said header to said stud whereby said slot permits said header to move vertically with respect to said stud while restricting horizontal movement of said header.

(App. A at 193). Further, in the remarks section of the response, applicant stated that:

> First, the Examiner's question of how the stud is aligned with the vertical slot has been answered by adding hole 22 proximal to top

> end 40 of the stud as an element of the claims. The hole 22 serves as a reference point on the stud which is used to align the stud and the slot. This amendment should overcome the Examiner's § 112 rejection based upon indefiniteness with respect to claim 1 and the claims dependent therefrom.

(App. A at 201).

However, in further response to the examiner's rejection, original claims 6 through 9 were cancelled, and five new claims were added.[3] (App. A at 194-195). In particular, newly added independent Claim 7 was specifically directed to the second embodiment. This is evidenced by the fact that Claim 7 contains the added limitation, "said hole formed in said stud located so that said top [e]nd of said header [sic, "stud"] is in contact with said bottom surface of said web when said attachment means is in contact with said upper end of said slot." (App. A at 194). This added limitation corresponds precisely with the language of the second embodiment:

> The holes 22 in said stud 12 are positioned so that when the header 10 is forced downward to its maximum downward position 44 such that the top 42 of the slot 24 is abutted against said attachment means 20, then the top 40 of the stud 12 will contact the bottom 38 of the web 14 of the header 10.

(App. A at 219; App. B at 9). Moreover, in adding Claim 7, applicant expressly stated that Claim 7 "includes the

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[3] Specifically, new claims 10 through 14 were added, which, when re-numbered, claim 10 became claim 6, claim 11 became claim 7, etc. (App. A at 192).

limitations of the particular embodiment described in the specification at page 7, lines 15-23." (App. A at 201-202). The embodiment described in "the specification at page 7, lines 15-23" is exactly the second embodiment. (App. B at 17).

II. Proceedings Below

On January 9, 1998, Slip Track filed a complaint in the Central District of California to institute an interference proceeding pursuant to 35 U.S.C. §291. (App. A at 179). Slip Track sought a determination that its '760 patent had priority over Metal-Lite, Inc.'s ("Metal-Lite") U.S. Patent No. 5,127,203 (the "'203 patent").[4] Slip Track also asserted claims for, *inter alia*, infringement of the '760 patent. Metal-Lite counterclaimed for, *inter alia*, infringement of its '203 patent and non-infringement and invalidity of the '760 patent.

On July 13, 1999, the District Court granted Metal-Lite partial summary judgment, finding that the '203 patent had priority over Slip Track's '760 patent. (App. A at 56). Slip Track appealed, and the Federal Circuit, in *Slip Track Sys., Inc. v. Metal Lite, Inc.*, 304 F.3d 1256 (Fed. Cir. 2002), vacated the District Court's grant of summary judgment of priority for the '203 patent and remanded. (App. A at 31).

The proceedings then advanced principally on the issue of which patent was entitled to priority. No *Markman* claim construction was ever proposed by either party. After conclusion of phase one of the trial on interference, the jury found that the '760 patent had priority. After phase two of the trial on the issues of infringement and damages, the jury awarded $7,000,000 in damages to Slip Track. (App. A at 28).

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[4] Both the '760 patent and the '203 patent had issued on the same day, July 7, 1992. (App. B at 1 and 5).

A. The Federal Circuit Decision

On appeal, Metal-Lite resurrected the claim construction issue. Succinctly framed, the issue is whether the claims of the '760 patent are limited to a stud with a hole drilled prior to inserting the stud into the header or whether the claims encompass products without such a pre-drilled hole. (App. A at 9-13). In other words, the issue is simply whether the claims are limited to the second embodiment only or whether the claims cover both embodiments described in the specification.

On this question, the Federal Circuit considered determinative textual language to be "said stud having at least one hole formed therein proximal to said top end" of Claim 1. (App. A at 9-13). In constructing the claim, the court relied exclusively on a singular remark found in the prosecution file that "[t]he hole serves as a reference point on the stud which is used to align the stud and the slot," which the court took to be dispositive. (App. A at 9-13). Consequently, the court—in a divided opinion—held that this claim language limits the claims to the second embodiment, requiring pre-drilled holes. (App. A at 9-13).

Slip Track petitioned for a panel rehearing and rehearing *en banc* on, *inter alia*, the following question of claim construction: whether the standard for applying the Doctrine of Prosecution Disclaimer should be refined to require that the clear and unmistakable disavowal of subject matter must be based upon a review of the intrinsic record as a whole in context and not just the statements alleged to have given rise to the disclaimer. The Federal Circuit denied the petition for panel rehearing and rehearing *en banc*. (App. A at 9-13).

REASONS FOR GRANTING THE WRIT

This case is highly appropriate for Supreme Court review because it is to direct infringement as *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831 (2002) was to infringement under the Doctrine of Equivalents. In *Festo*, the Supreme Court recognized that the Doctrine of Equivalents had become so amorphous that the scope of protection provided by a patent claim had become disconnected from the plain meaning of the words of the claim. This Court used the file history of the patent to imposed clear restraints on what could be considered equivalent so that the patentee and the public could reliably predict the scope of protection granted under the Doctrine of Equivalents. This Court created a bright line test that if the patent owner surrendered subject matter during prosecution of the patent, it was presumed that he could not re-claim the subject matter under the Doctrine of Equivalents. In this case, the same thing must be done with respect to direct infringement.

In the case of direct infringement, it is the plain meaning of the words of the claim that define the rights. If the words of the claim are clear, then the claim itself defines the scope of protection granted. A clearly written claim provides notice to both the patent owner and the public of the legal boundary lines around the invention drawn by the patent. The claim defines the contract between the patent owner and the public concerning the scope of the limited monopoly. Both the public and patent owner are entitled to rely upon the words of that contract. Yet, the Federal Circuit has drifted far from this fundamental notice function of a patent claim.

Just as this Court found the need to limit the Doctrine of Equivalents by use of the file history in *Festo* in order to better define the rights granted by a patent, there is

a need to restore clear definition to direct infringement analysis. While the file history helped restore order to the Doctrine of Equivalents in *Festo*, the file history is now being used in the direct infringement setting to muddle the plain meaning of patent claims by importing limitations from the file history even when the claim is clearly defined and requires no clarification. The purpose of the file history in the direct infringement setting should be to clarify ambiguities in claims; not to create them. Yet, the expanded use of file histories arising out of *Festo* has spilled over into direct infringement analysis so that the Federal Circuit is now using ambiguities in the file history in order to insert limitations in claims that are clear on their face. This was never the intention of *Festo*.

For direct infringement, the clear high hierarchy of analysis must be restored: If the claim is clear on its face after reviewing the claim and description of the invention in the patent itself, then there is no reason to look any further. The scope of the claim is defined within the four corners of the patent document itself. If the claim is still unclear, then the file history can be consulted for clarification. If the claim is still not clear, then extrinsic evidence can be consulted such as dictionaries and experts if needed. But importing limitations from the file history into a claim that is clear on its face destroys the basic notice function of a claim and leaves both the patent owner and the public guessing as to the real meaning of the claim. *Festo* addressed this problem in the Doctrine of Equivalents setting. It is now time to address this fundamental issue in the direct infringement setting.

Accordingly, this Petition invites the Court to consider how prosecution history is to be used in claim construction, particularly as a basis for the doctrine of disclaimer. As such, this Petition is directed to the very

methodology of claim construction and, thus, to the heart of patent law.

I. CERTIORARI SHOULD BE GRANTED TO RESTORE BALANCE TO TRADITIONAL CLAIM CONSTRUCTION METHODOLOGY BY CIRCUMSCRIBING THE DOCTRINE OF PROSECUTION HISTORY DISCLAIMER

The Court should grant this Petition for Writ to restore claim construction to the working methodology developed over nearly two centuries of American patent law, from which the Federal Circuit has hastily deviated in its recent decisions.

By its own recent admission, the Federal Circuit has stated that its case law on claim construction is "unfortunately complex and inconsistent." *Astrazeneca AB v. Mutual Pharmaceutical Co.*, 384 F.3d 1333, 1336 (Fed. Cir. 2004). The Federal Circuit acknowledged in particular that its recent decisions appear to suggest two distinct and incongruent approaches to claim construction. Under one line of cases, evidence intrinsic to the patent is the primary source for determining claim meaning. *See Astrazeneca*, 384 F.3d at 1336-37 (citing, *e.g.*, *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1268 (Fed. Cir. 2001)). Under another line of cases, the intrinsic record should only be consulted after the ordinary and customary meaning of the claim term is determined. *See Astrazeneca*, 384 F.3d at 1336-37 (citing, *e.g.*, *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002)). Where the ordinary meaning of the claim is evident, the intrinsic record is relevant only insofar as it provides clear lexicography or *clear disavowal* of the ordinary meaning. *See id.* Between these two trench lines of claim construction, a doctrinal struggle is being waged in the lower courts over how and when the intrinsic record—specifically, in this

instance, the prosecution history—is to be used to construct or deconstruct the claim of a patent.

In this struggle, the Federal Circuit has demonstrated an increasingly unrestrained inclination to use the prosecution history to narrow patent claim under the doctrine of prosecution history disclaimer. In recent cases, the Federal Circuit has expanded the doctrine of prosecution disclaimer in a manner that has not only sown confusion in claim construction, but has unbalanced the patent regime by weakening the fundamental principle that a patent is defined by the claim. The expansion of prosecution disclaimer is indicative of the Federal Circuit's continuing departure from traditional claim construction methodology.

A. The Architecture of the Patent Regime: the Relation Between Claim and Prosecution History in Claim Construction

1. Patent Law Is Based on the "Fundamental Principle" That Claims Define the Scope of Patent Protection

Throughout the modern history of United States patent law, courts have recognized claim language as the measure of the exclusive rights conferred by a patent. This Court long ago stated that the claims made in the patent are the measure of the invention. *See Continental Paper Bag Co. v. E. Paper Bag. Co.*, 210 U.S. 405, 419 (1908). It is the first axiom of patent law, one the Federal Circuit itself has religiously invoked: "[b]oth the Supreme Court and this court have adhered to the fundamental principle that claims define the scope of patent protection." *Johnson & Johnson Associates, Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046, 1053 (Fed. Cir. 2002).

It follows from this "fundamental principle" that the scope of the patent cannot be altered by hindsight reference to the intrinsic record.

> The context may, undoubted, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claims; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.

White v. Dunbar, 119 U.S. 47, 51-52 (1886). Although a claim is to be interpreted in light of the specification and prosecution history, it is a canonical rule that it is improper and impermissible to import a limitation into a claim from the specification or the prosecution history. *See, e.g., Tate Access Floors, Inc. v. Maxcess Technologies, Inc.*, 222 F.3d 958, 966 (Fed. Cir. 2000). This rule flows from the fundamental principle that "it is the function and purpose of the claims," not the specification or the prosecution history, to "delimit the right to exclude." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). However, as the Federal Circuit recognized, "there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification." *See Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182 (Fed. Cir. 1998).

2. Claim Construction Methodology

The Federal Circuit is undermining the basic architecture of the patent regime by blurring the fine line

between reading a claim in light of the intrinsic evidence, and reading a limitation into the claim from the intrinsic evidence. In decision after decision, the court has labored to read limitations into claims by inconsistently and often incorrectly applying prosecution history as a means toward finding disclaimer. In so doing, the Federal Circuit has fundamentally subverted traditional claim construction methodology.

In claim construction, the established methodology is to look to the claims first, then the specification, and then the prosecution history if necessary. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (delineating a hierarchy among the intrinsic evidence).[5] The claims are accorded primacy in this hierarchy of intrinsic evidence for the simple reason that they "provide the formal definition of the invention." *Autogiro Co. of America v. United States*, 384 F.2d 391, 395 (Ct. Cl. 1967). Since the language of the claim defines the boundary of its scope, there is a "heavy presumption" in favor of the "ordinary meaning" of a claim. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999). This is the "ordinary and accustomed meaning" rule, which stands for the basic proposition that the ordinary meaning of a claim is to be controlling, unless there is clear indication in the intrinsic record to find otherwise.

In order to overcome the heavy presumption accorded the ordinary meaning of the claim language, the claim itself must invite reference to the intrinsic record. *See*

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5 *See, e.g., Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002) ("Consulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.").

Johnson Worldwide, 175 F.3d at 989-90.[6] This is because "[i]f we once begin to include elements not mentioned in the claim in order to limit such claim ...," as this Court has opined, "we should never know where to stop." *Johnson Worldwide*, 175 F.3d at *990* (quoting *McCarty v. Lehigh Val. R.R.*, 160 U.S. 110, 116 (1895)).

"If the claim language is clear on its face, consideration of the rest of the intrinsic evidence is restricted to determining if a deviation from the clear language of the claims is specified." *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001). Under Federal Circuit case law, there are only two situations where it would be proper to look beyond the ordinary and accustomed meaning of the claim. The first case, inapplicable here, is where the patentee has chosen to be his own lexicographer. *Johnson Worldwide*, 175 F.3d at 990. The second is where "the term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used." *Id.* In particular, the prosecution history can be found to have a disclaiming effect on the ordinary meaning of a claim where: 1) the patentee narrowed a claim after it was rejected by the Patent Office; and 2) where the limiting effect is "indisputable" or "clear and unmistakable" or "unequivocal." *See Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003). In short, claim construction is predicated on a "heavy presumption in favor of the ordinary meaning of a claim," which can only be overcome by "clear an unmistakable disclaimer."

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[6] *See, e.g., Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 950 (Fed. Cir. 1993) ("It is improper for a court to add extraneous limitations to a claim, that is limitations added wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim").

B. The Expanding Use of Prosecution History Disclaimer Is Inconsistent with Traditional Claim Construction Methodology

There has been a gradual and growing trend in Federal Circuit jurisprudence towards an expanded use of the specification and prosecution history to attack the claim, even when its ordinary and accustomed meaning is clear, and even when the claim does not invite reference to the intrinsic record.

Beginning with *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, the Federal Circuit expanded the use of the written description in determining the meaning of claim language. 242 F.3d 1337, 1344 (Fed. Cir. 2001). The court embraced a claim construction framework wherein the written description can "provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format." *Id.* Then in *CCS Fitness, Inc. v. Brunswick Corp.*, the Federal Circuit held that a court may limit otherwise clear claim terms where, *inter alia*, the patentee expressly disclaimed subject matter. 288 F.3d 1359 (Fed. Cir. 2002). Most recently in *Teleflex, Inc. v. Ficosa North America Corp.*, the Federal Circuit refined the rule developed in *SciMed* and *CCS Fitness*, expressly holding that the "clear disavowal" must be made by "words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." 299 F.3d 1313, 1327 (Fed. Cir. 2002). This line of cases is indicative of an evolving jurisprudence in which the Federal Circuit is drifting away from the claim-center of the patent regime.

In moving away from a construction methodology centered on the plain meaning of the claim, the Federal Circuit has struggled to reconcile the two conflicting canons of claim constructions: that a claim is to be interpreted in light of the specification and prosecution history, but a

limitation cannot be imported into the claim from the specification or the prosecution history. From this doctrinal schism two lines of cases have developed, as acknowledged in *Astrazeneca, supra.* One line is comprised of Federal Circuit decisions holding that claims are construed according to their ordinary and accustomed meaning, unless the claim itself invites reference to the intrinsic record expressly, or unless the claim is unclear. The other line is comprised of Federal Circuit decisions holding that the claim should be limited anytime the intrinsic record evidences disclaimer of the subject matter.

In light of the Federal Circuit's inconsistent, if not rather schizophrenic, case law on claim construction, lower courts are confused as to how to apply prosecution history to patent claim.[7] There is no clear guidance for how and when disclaimer is to be found. As a result, patent holders cannot litigate claim construction issues with any predictability and courts cannot adjudicate them with any certainty.[8]

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7 *See, e.g.,* Gretchen Ann Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time Is Ripe for a Consistent Claim Construction Methodology,* 8 J. Intell. Prop. L. 175, 215 (2001) ("A sampling of Federal Circuit cases quickly demonstrates that even the Federal Circuit does not follow a consistent claim construction methodology."); Tarek N. Fahmi & Elena B. Dreszer, *De Novo Review of Claims Construction or Wasted Effort of the District Court: Interactive Gift Express, Inc. v. Compuserve, Inc.,* 19 Santa Clara Computer & High Tech. L.J. 315 (2002) ("[E]mpirical studies by various authors, including one of the Federal Circuit's own judges, have shown that uniformity is conspicuously absent when it comes to issue of claims construction in patent litigation." (footnote omitted)).

8 *See, e.g.,* Steven B. Pokotilow & Charles E. Cantine, *File Early and File Often A Pending Application is the Best Approach to Capturing Your Competitor's Product,* PATENT STRATEGY & MGMT, Jan. 28, 2004, at 1 ("In sum, due to the ever-changing case law on claim interpretation, neither applicants or their attorneys are in a position to predict accurately how a district court, or the Federal Circuit, will interpret a given set of claims.").

C. The Disclaimer Doctrine Is Being Misapplied by the Federal Circuit in a Manner That Is Contrary to Precedence and to the Canons of Claim Construction

This confusion has culminated in the instant case, wherein the Federal Circuit has continued to broaden the disclaimer doctrine in a manner that is wholly contrary to precedence and, moreover, that is in jarring conflict with established canons of claim construction. It did this by applying a confused construction methodology: the Federal Circuit failed to first construct the ordinary meaning of the claims in issue. Disregarding the clear meaning of the claims, the court instead looked directly to the prosecution history for disavowal. In the rush to do so, it failed to consider the entirety of the prosecution history, and thus overlooked the particular claim amendment and argument that would have required the court to differentiate the claims. As discussed below, had the claims been properly differentiated, the court could not logically have found disavowal.

1. Prosecution History Disclaimer Is Improper Where the Intrinsic Record Contains Evidence Contrary to the Allegedly Disavowing Statement and the Record *as a Whole* Does Not Show Clear and Unmistakable Disavowal

The Federal Circuit has stated that, "precedence requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable." *Omega Eng'g*, 334 F.3d at 1325-26. In determining whether the actions or statements made during prosecution constitute clear and unmistakable disavowal, the Federal Circuit has remarked in dictum that the totality of the prosecution history must be considered. *See Rheox, Inc. v.*

Entact, Inc., 276 F.3d 13119, 1326 (Fed. Cir. 2002) ("We assess whether a patentee relinquished a particular claim construction based on the totality of the prosecution history...", citing *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979 (Fed. Cir. 1999)). The question presented by this Petition is whether there can ever be clear and unmistakable disavowal if there is evidence in the totality of the intrinsic record that is inconsistent or conflicting with the purported disavowal.

a.) The Disclaimer Doctrine as Applied in This Case Conflicts with the Canon of Claim Differentiation

When the totality of the intrinsic record is considered in the present case, it becomes clear that the Federal Circuit's interpretation of the specific prosecution remarks in issue as constituting clear disavowal conflicts with the doctrine of claim differentiation. This is because the patentee's remarks as interpreted would be at odds with the patentee's own claim amendments.

Under the doctrine of claim differentiation, claims are presumed to be of different scope. *See Telemac Cellular Corp. v. Topp. Telecom, Inc.*, 247 F.3d 1316, 1325 (Fed. Cir. 2001). The '760 patent contains two independent claims: claim 1 and claim 7.[9] Claim 1 was originally drafted to cover the two embodiments disclosed in the written description. In response to the examiner's rejection, claim 7 was added, specifically directed to the second embodiment (*i.e.* the "pre-drilled" embodiment). It would have been

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[9] As noted above, in the original application there were nine claims. In response to the examiner's rejection, claims 6 through 9 were cancelled, and new claims 10 through 14 were added, which, when re-numbered, claim 10 became claim 6, claim 11 became claim 7, etc. (App. A at 213).

redundant to add claim 7 if—as the Federal Circuit interpreted it—claim 1 was limited to the pre-drilled/second embodiment by way of disclaimer.

That the two claims are separately directed to the two distinct embodiments—the first including self-tapping screws and the second requiring pre-drilling of the holes—is supported by the fact that claim 7 contains the added limitation, "said hole formed in said stud located so that said top [e]nd of said header [sic, "stud"] is in contact with said bottom surface of said web when said attachment means is in contact with said upper end of said slot." (App. B at 9). This added limitation corresponds directly to the second embodiment requiring pre-drilling of the holes.

Further, that claim 7 is directed to the second embodiment can be easily tracked from the prosecution history. In adding claim 7, patentee expressly stated that claim 7 "**includes the limitations of the particular embodiment described in the specification at page 7, lines 15-23.**" (App. A at 201-202). The embodiment described in the specification at page 7, lines 15-23 is the pre-drilled/second embodiment. (App. B at 17). Thus, the prosecution history shows that claim 7 is indisputably directed to the second embodiment.

The Federal Circuit's claim construction treated claim 7 as being essentially identical to claim 1, conflating the two claims by requiring that both be limited to a pre-drilled hole embodiment. This failure to differentiate the claims caused the court to interpret claim 1 to be superfluous to claim 7. *See, e.g., Beachcombers, International, Inc. v. WildeWood Creative Products, Inc.*, 31 F.3d 1154, 1161 (Fed. Cir. 1994) (stating an interpretation of a claim that would render another claim in the patent "superfluous" is "presumptively unreasonable").

Accordingly, the narrow question presented by this Petition is whether it is ever appropriate to apply the doctrine of prosecution history disclaimer when, as here, the intrinsic record contains evidence contrary to the allegedly disavowing statement and the record *as a whole* does not show a clear and unmistakable disavowal. It is submitted that where there is conflicting or inconsistent evidence in the prosecution history taken as a whole, as here, there cannot *per se* be clear disavowal.

2. The Federal Circuit's Application of the Disclaimer Doctrine Also Conflicts with the Canonical Prohibition Against Reading a Limitation Into a Claim

Further, the Federal Circuit's expanded application of prosecution history disclaimer also vitiates a cardinal prohibition against reading a limitation into a claim. This rule has been deemed "fixed" and "immutable." *See D.M.I. v. Deere & Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985). The Federal Circuit completely disregarded this rule in its construction of the claim in the present case. The court read in the "pre-drilled" limitation based on the patentee's remark that the hole "serves as a reference point." The ambiguity resides in the word "reference," but that is not a term of the claim language, and any dispute as to its meaning was irrelevant to construction of the claim. "The danger of improperly importing a limitation is even greater when the purported limitation is based upon a term not appearing in the claim." *Amgen Inc. v. Hoeschst Marrion Roussel, Inc.*, 314 F.3d 1313, 1325 (Fed. Cir. 2003). Therefore, *how* the hole functions as a "reference" is an extraneous limitation, one that was improperly imported into the claim.

It is contrary to established construction practice to look for disclaimer in the prosecution history if, to do so, it would mean the reading of a limitation into the claim. As a

matter of policy and of practice, the disclaimer doctrine cannot be applied in a manner that would subvert a fixed and immutable rule of claim construction.

3. The Federal Circuit's Application of the Disclaimer Doctrine Further Conflicts with the Canon of Reading Out a Preferred Embodiment

Not only does the finding of disclaimer conflicts with the rule against reading-in a limitation, it conflicts with the rule against reading-out a preferred embodiment. It is "rarely, if ever, correct" for a claim construction to read out the preferred embodiment.[10] *See Vitronics*, 90 F.3d at 1583-84; *see also, Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1580-81, (Fed. Cir. 1996) (noting "it is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment, or that persons of skill in this field would read the specification in such a way").

Notwithstanding its own admonition against reading out a preferred embodiment, the Federal Circuit constructed the claim in issue to exclude the preferred embodiment. That its claim construction is contrary to its own canons exemplifies the problem of failing to adhere to traditional claim construction methodology in applying disclaimer.

D. This Court Should Circumscribe the Disclaimer Doctrine

In short, the Federal Circuit departed from a host of claim construction canons in applying the doctrine of

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[10] Since it is "rarely, if ever, correct" for a claim construction to read out the preferred embodiment, the Federal Circuit itself has rarely approved of such a construction. *See, e.g., Rheox, Inc. v. Entact, Inc.*, 276 F.3d 1319, (Fed. Cir. 2002); *Elekta Instruments S.A. v. O.U.R. Scientific Int'l., Inc.*, 214 F.3d 1302 (Fed. Cir. 2000).

disclaimer. Specifically, the Federal Circuit strove to find "clear disavowal" in this case, even though 1) the claim in issue on its face covered the preferred embodiment; 2) finding disavowal required that the claims not be differentiated; 3) finding disavowal required that an express claim amendment be ignored; 4) finding disavowal required excision of the preferred embodiment from the claim scope; and 5) finding disavowal meant the claim in issue would be converted from a product claim into a process claim. As such, under the claim construction methodology currently practiced by the Federal Circuit, "clear disavowal" is anything but clear.

This Court should restore traditional claim construction methodology by limiting the expanding "clear disavowal" exception to prevent it from undermining the ordinary meaning of the claim. As the proverbial saying goes, the exception is swallowing the rule. Therefore, the disclaimer exception should be limited by requiring that the clear and unmistakable disavowal of subject matter be based upon a review of the intrinsic record as a whole, in context, and not just the statements alleged to have given rise to the disclaimer. Where there is manifestly conflicting or inconsistent evidence in the intrinsic record as to whether an applicant intends to disavow subject matter, there is no disavowal *per se*. This Court should define "clear disavowal" to require that it be manifest in the totality of the prosecution history.

II. PROSECUTION HISTORY DISCLAIMER SHOULD BE LIMITED TO AMENDMENTS OR ARGUMENTS MADE TO OVERCOME PRIOR ART

The trend towards a more gratuitous use of prosecution history disclaimer to adversely narrow claim scope has notably accelerated in the aftermath of *Festo*. This Court undertook *Festo* to restrain the Federal Circuit from

overreaching in its use of estoppel to effectively gut the doctrine of equivalents. The Federal Circuit is now overreaching in its application of prosecution disclaimer, misusing the disclaimer doctrine in claim construction as it had misused estoppel in non-literal infringement. The misuse of prosecution disclaimer in claim construction here, however, raises far more concern than that of estoppel in *Festo*, because it undermines the very methodology of claim construction that has been the foundation of the patent law.

Therefore, this Court should further restore balance to claim construction by limiting the doctrine of prosecution history disclaimer to amendments or arguments made to overcome prior art. As presently applied, any amendments or arguments that purport to manifestly exclude or restrict the claimed subject matter can be a basis for disclaimer. In the present case, for example, the examiner rejected the original claims of the '760 Patent under 35 U.S.C. § 112, second paragraph, as being indefinite. This was not a rejection over prior art and the responding amendments did not narrow the claims to a pre-drilled embodiment to overcome prior art. Nonetheless, the Federal Circuit held that the responding amendments, which had been made to more definitely claim the invention, manifested disavowal of the preferred embodiment. Petitioner submits that amendments or arguments made for definiteness should not be a basis for disclaimer because, unlike prosecution history estoppel—which is a shield against an assertion of equivalents—disclaimer is a narrow exception to the ordinary meaning rule of claim construction; therefore, disclaimer should not be used broadly as a sword for invalidating a patent claim.

A. Prosecution Disclaimer Is Fundamentally Different from File History Estoppel Under the Doctrine of Equivalents

The concept of Prosecution Disclaimer is a fundamentally different animal from file history estoppel under the Doctrine of Equivalents. Prosecution Disclaimer is an agreement between the Patent Examiner and the applicant as to what cannot be included within the scope of protection. Based upon this understanding, the Examiner and the applicant agree to certain claim language. Since the Examiner is presumably aware of what has been disclaimed in his exchanges with the applicant, the resulting claims that the Examiner allows presumably do not include what was excluded by the disclaimer. Yet, the Federal Circuit has used Prosecution Disclaimer to expand the disavowed subject matter beyond the plain language of the claim agreed upon by the Examiner as if it were the same as prosecution history estoppel. This is wrong. Prosecution disclaimer in the direct infringement setting is fundamentally different than prosecution history estoppel under the Doctrine of Equivalents. The consequences of a disclaimer is intrinsically contained in the words of the final patent claim agreed upon by the Examiner because the Examiner would not allow a claim that contained language that plainly covered what was disclaimed. The Doctrine of Equivalents involves expansion of the meaning of the claim beyond its four corners, which does not appear in the plain language agreed upon by the Examiner. To impose limitations on the Doctrine of Equivalents, file history estoppel requires interpretation by the courts where the limitations imposed by Prosecution Disclaimer presumably collapse into the plain language of the claim that is accepted by the Examiner. Yet, the Federal Circuit has never acknowledged this fundamental difference. This fundamental difference must be recognized to prevent Prosecution Disclaimer from overtaking the fundamental

principle that the plain language of the claim defines the patent right.

1. The Federal Circuit Fails to Differentiate the Use of Prosecution History as a Means Toward Claim Construction from Prosecution History as a Means Toward Estopping Equivalents

In *Southwall Technologies, Inc. v. Cardinal IG Co.*, the Federal Circuit observed "[t]here is ... a clear distinction between following the statements in the prosecution history in defining a claim term, and the doctrine of prosecution estoppel, which limits expansion of the protection under the doctrine of equivalents when a claim has been distinguished over relevant prior art." 54 F.3d 1570, 1579 (Fed. Cir. 1995). In essence, where the doctrine of equivalents only involves the secondary determination of how far *outside* the literal scope of a patent claim infringement may be found, claim construction involves the primary determination of what is *within* the literal scope of a patent claim. Hence, disclaimer is paradigmatically different from estoppel. The two distinct concepts are rooted in different equitable and public policy principles and are applied by different methodologies.

Yet the Federal Circuit fails to differentiate disclaimer from estoppel because it does not differentiate the proper use of the prosecution history as a secondary textual basis for claim construction from its use as an affirmative defense to an assertion of non-literal infringement. As a result, the Federal Circuit often reads the prosecution history for the purpose of finding disclaimer under claim construction as broadly as it would read it for the purpose of finding estoppel under non-literal infringement. Such a broad reading is unbalanced, for it tips the prosecution history too heavily against the claim.

The prosecution history should be read much more stringently for purpose of claim construction than for non-literal infringement analysis.

B. The Effect of *Festo*

Previously in *Festo*, this Court fully explicated the doctrine of prosecution history estoppel, noting the underlying rationale:

> When ... the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised *unforeseen subject matter* that should be deemed equivalent to the literal claims of the issued patent.

122 S.Ct. at 1838 (emphasis added). Accordingly, the Court went on to hold, *inter alia*, that amendments made for any reason relating to patentability could give rise to estoppel. *See* 122 S.Ct. at 1839. This holding was based on the recognition by the Court of the need for reducing the degree of uncertainty created by the doctrine of equivalents.

> Prosecution history estoppel ensures that the doctrine of equivalents remains tied to its underlying purpose. Where the original application once embraced the purported equivalent but the patentee narrowed his claims to obtain the patent or to protect its validity, the patentee cannot assert that he lacked the words to describe the subject matter in question. The doctrine of equivalents is premised on language's inability to capture the essence of innovation...

Festo, 535 U.S. at 735. Thus, the broadening of estoppel in *Festo* was designed to counterbalance the uncertainty inherent in the doctrine of equivalents. This policy concern does not underpin the concept of disclaimer in claim construction, however. On the contrary, since it is the claim that provides notice to the world of the metes and bounds of the patent, to apply prosecution history as broadly for disclaimer as for estoppel would be to undermine the notice function of the claim itself. In particular, it would subvert the "ordinary meaning" rule that is meant to confer greater certainty as to what the patentee regards as his invention.

Before *Festo*, it was generally held that amendments made for clarification did not create estoppel. As this Court noted in *Festo*,

> Our prior cases have consistently applied prosecution history estoppel only where claims have been amended for a limited set of reasons, such as to avoid the prior art, or otherwise to address specific concern—such as obviousness—that arguably would have rendered the claimed subject matter unpatentable.

Festo, 535 U.S. at 735 (quoting *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 30-32 (1997) (recognizing that prosecution history estoppel does not arise in every instance when a patent application is amended)). Indeed, many lower court decisions before *Festo* routinely held that amendments made for clarification did not create an estoppel.

The logic and rationale of *Festo* in broadening the reach of estoppel do not apply to claim construction and, thus, the Federal Circuit should not have taken *Festo* as a green-light for expanding the disclaimer exception. But it

has. The Federal Circuit has enlarged the doctrine of disclaimer to cover amendments or arguments made for any reason relating to patentability, including, in particular, amendments or arguments made under Section 112.

As disclaimer is a narrow exception to the ordinary meaning rule of claim construction, it should not cover amendments or arguments made under Section 112. It should properly be found only for amendments or arguments made to overcome prior art because, in practice, an applicant typically disclaims subject matter only in order to overcome prior art—as this Court implicitly recognized in *Warner-Jenkinson* and later in *Festo*. *See Festo*, 535 U.S. at 735. It is typically not necessary to disclaim subject matter in order to overcome indefiniteness under Section 112. Thus, to define disclaimer as broadly as estoppel for the purpose of invalidating a claim not only does not serve to further any principles of patent law, it is actually inconsistent claim construction practice.

Furthermore, the distinction between using prosecution history to interpret a claim and using it as estoppel is most strained when, as here, a court finds that an applicant apparently disclaims subject matter that falls within the clear literal scope of the claim. This is never possible with estoppel since, by definition, estoppel only arises when there is no literal infringement. It is precisely because the scope of the claim is neither literal nor clear under the doctrine of equivalents that estoppel is to be applied broadly and forcefully. By contrast, for claim construction, if the subject matter falls within the clear literal scope of the claim, then the disclaimer exception should be applied narrowly to preserve the literal scope of the claim.

To be sure, *Festo* significantly impacted the law of non-literal infringement, but its shadow should not darken the landscape of claim construction. Accordingly, this Court

should grant writ to limit the disclaimer exception to amendments or arguments made to overcome prior art in order to preserve the primacy and predominance of the claim that has always been the bedrock of American patent law.

CONCLUSION

For the reasons set forth above, this Petition should be GRANTED.

Respectfully submitted,

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